

### **REMARKS**

The Office Action dated December 21, 2004, has been received and carefully noted. The following remarks are submitted as a full and complete response thereto.

Claims 1-19 are currently pending in the present application, and are respectfully submitted for reconsideration.

#### **Allowable Subject Matter**

As a preliminary matter, Applicant appreciates the indication of allowable subject matter in claims 10-16.

#### **Claims 1 and 17 Rejected Under 35 U.S.C. § 103(a)**

Claims 1 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Satoh (U.S. Patent No. 5,982,981, hereinafter "Satoh"). Applicant respectfully traverses the rejection and submits that each of these claims recites subject matter that is neither disclosed nor suggested by the cited prior art.

Claim 1 recites an image processing apparatus comprising, among other features, an image memory including a first memory area to store a first image data group of a first image for a background and a second memory area for storing a second image data group of a second image for an on-screen display; a display buffer memory for storing the first image and the second image read from said image memory, in a format to be displayed on a display screen, and wherein a control section includes a data expansion control section capable of increasing a data amount of the second

image data group read from said image memory, according to the second image data group.

Claim 17 recites an image processing method, comprising the steps of: (a) storing, in an image memory, a first image data group for a background and a second image data group for an on-screen display; (b) reading the first image data group for a background and the second image data group for an on-screen display from the image memory and increasing a data amount of the second image data group; and (c) displaying, on a display screen, the first image data group and a second image data group of which the data amount is increased.

It is respectfully submitted that the prior art fails to disclose or suggest at least the combination of the above-mentioned features of the Applicant's invention.

The Office Action characterized Satoh as allegedly disclosing "an image memory (image memory 44, Fig. 12); a display buffer memory (buffer memory 35, Fig. 11); and a control section (system controller 8 & frame memory controller 6, Fig. 11) for controlling accessed to image memory and display buffer memory ... [and] data expansion control section (image data comp./decomp. Ckt 7, Fig. 11) capable of increasing a data amount (col. 6, lines 57-67; col. 7, lines 1-51) and the on-screen display data with background (... when switch is...operated...the residual recording capability...is displayed on ...EVF 15...col. 6, lines 25-44)."

Applicant respectfully disagrees with the Office Action's characterization of Satoh and therefore traverses the rejection.

Figure 11 of Satoh discloses one embodiment of an electronic imaging apparatus. Figure 11 and corresponding disclosure in column 6, line 61 to column 7, line 4 of Satoh provide,

...switches 31, 32, 36, 38, buffer memory 35 and sound data compressing/decompressing circuit 37. The switch 32 switches inputs to A/D converter 34. The switch 31 switches the output from D/A converter 33. The switch 36 switches the connection of image data compressing/decompressing circuit 7 and the connection of sound data compressing/decompressing circuit 37 to buffer memory 35. The switch 38 switches the connection of image data compressing/decompressing circuit 7 and that of sound data compressing/decompressing circuit 37 to interface 9.

In addition, Figure 12 of Satoh shows "a further embodiment" of the electronic imaging apparatus which "permits simultaneous play-back of image and sound information." Figure 12 and the corresponding disclosure in column 7, lines 15-33 provide,

[an] image memory 44 and sound memory 45 [that] are provided separately, and the image data and sound data provided through switch 32 and A/D converter 34 are recorded in the corresponding memories through switch 43. The sound and image processing lines include respective D/A converters 41 and 42 for converting data read out from sound and image memories 45 and 44 into analog signals.

Image data read out from recording medium 10 is supplied through switch 38 to image data compressing/decompressing circuit 7 for decompression processing before being recorded in image memory 44. In a similar manner, sound data read out from recording medium 10 is decompressed in sound data compressing/decompressing circuit 37 before being recorded in sound memory 45. The image and sound data read out respectively from image and sound memories 44

and 45 are converted in D/A converters 42 and 41 into analog signals to obtain simultaneous play-back outputs.

Applicant submits that Satoh fails to disclose or suggest each and every element recited in claims 1 and 17 of the present application for at least the following reasons.

It is submitted that the buffer memory 35 and the image memory 44 of Satoh cited above are neither comparable nor analogous to the “display buffer memory” and the “image memory” of the present invention, respectively, as claimed. For instance, the image memory 44 of Satoh does not have a first memory to store a first image data group of a first image for a background and a second memory area for storing a second image data group of a second image data group of a second image for an on-screen display, as claimed in claim 1. Similarly, the cited buffer memory 35 of Satoh does not store the first image and the second image read from the image memory, in a format to be displayed on a display screen. Hence, Satoh does not show or suggest at least the combined features of “display buffer memory ...” and “image memory...”, as claimed in claim 1.

Moreover, Applicant submits that Satoh fails to disclose or suggest at least the combination of features of “said control section includes a data expansion control section ... according to the second image data group” with respect to claim 1, and the step of “displaying ... the first image data group and a second image group of which the data amount is increased” as claimed in claim 17. Nowhere does Satoh disclose at least this combination features. The cited image data comp/decomp circuit 7 of Satoh is

neither comparable nor analogous to the data expansion control section, and the respective step of the present invention, as claimed.

In addition, Applicant submits that Satoh fails to disclose or suggest “an image memory” and “a display buffer memory” in a single operational embodiment. Although Figure 11 of Satoh shows a buffer memory 35, and Figure 12 of Satoh shows an image memory 44, they are nevertheless in two separate and distinct embodiments, and do not appear in one single embodiment, as recited in the claimed invention. In short, Satoh only includes the feature of “an image memory 44” in one embodiment and does not have the “buffer memory 35”. On the other hand, Satoh only includes the feature of a “buffer memory 35” without the “image memory 44” in a second and separate embodiment. Satoh does not teach combining the two features in one embodiment, and there is not suggestion or motivation in Satoh to do so either.

To qualify as prior art under 35 U.S.C. §102, a single prior art reference must teach, i.e., identically describe, each feature of a rejected claim (see, e.s., MPEP§ 2131). As explained above, Satoh fails to disclose or suggest at least the combination of indicated features of claims 1 and 17. Accordingly, Applicant respectfully submits that claims 1 and 17 are not anticipated by nor rendered obvious by Satoh. Therefore, Applicant respectfully submits that claims 1 and 17 are allowable.

Accordingly, Applicant respectfully requests withdrawal of the rejection.

**Claims 2-9, 18 and 19 Rejected Under 35 U.S.C. § 103(a)**

Claims 2-9, 18 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Satoh in view of Matsushita (US Patent No. 6,664,970).

Applicant respectfully notes that claims 2-9 depend from claim 1, and claims 18 and 19 depend from claim 17. Therefore, it is respectfully submitted that claims 2-9, 18 and 19 are allowable for at least the same reasons claims 1 and 17 are allowable, as well as for the additional subject matter recited therein.

Further, with respect to the rejections under §103, under U.S. patent practice, the PTO has the burden to establish a *prima facie* case of obviousness. In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002). The Office Action restates the advantages of the present invention to justify the combination of references. There is, however, nothing in the applied references to evidence the desirability of these advantages in the disclosed structure.

Applicant respectfully requests withdrawal of the rejection.

## **Conclusion**

In view of the above, Applicant respectfully submits that each of claims 1-19 recites subject matter that is neither disclosed nor suggested in the cited prior art. Applicant also submits that the subject matter is more than sufficient to render the claims non-obvious to a person of ordinary skill in the art, and therefore respectfully request that claims 1-19 be found allowable and that this application be passed to issue.

If for any reason, the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact the Applicant's undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper has not been timely filed, the Applicant respectfully petitions for an appropriate extension of time.

Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300 referencing Attorney Docket No. 107317-00030.

Respectfully submitted,



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